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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/221,554	12/28/1998	BARRY C. ARKLES	08743-3U2	4427

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ONE COMMERCE SQUARE
2005 MARKET STREET, SUITE 2200
PHILADELPHIA, PA 19103-7013

EXAMINER

MOORE, MARGARET G

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 03/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/221,554

Applicant(s)

ARKLES ET AL.

Examiner

Margaret G. Moore

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12/20/-2.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 to 25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 5, 8, 9, 11 to 19, 22 to 25 is/are rejected.
- 7) ☒ Claim(s) 3,4,6,7,10,20 and 21 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 8, 11, 12, 14, 16 to 18 and 23 - 25 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Schank.

4. Claims 2, 5, 13 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schank.

These rejections rely on the rationale of record. The Examiner has carefully considered applicants' remarks but they are not persuasive in establishing an inherent difference between the claimed siloxane and that in the prior art.

With regards to the weight given "thermally labile", applicants state that the specification teaches that "moderate temperature conditions" are required, and defines this as above e.g. 150°C. They contrast this to the fact that Schank is directed to high temperature elastomers and that these elastomers do not degrade at low or elevated temperatures and conclude that the polymers of Schank would not have inherently the same properties as the claimed polymers.

However one must consider the context in which Schank refers to low or elevated temperatures. The siloxanes in Schank are being used in an electrophotographic imaging member. The degrading referred to in column 3 mentions cycling conditions over an extended period of time at low or elevated temperatures. However, one having ordinary skill in the art would not have expected an elevated temperature under cycling

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conditions to reach above 150°C, or above 300°F. Notice for instance that in the working examples, compositions are tested at 20°C and then 26°C. Thus reading the whole of Schank, one would not expect the elevated temperatures referred to therein to overlap with the “moderate temperature conditions” required for lability in the instant claims.

In addition, one must consider that a statement of heating at a temperature of above about 150°C could mean heating at a temperature of 500°C, the term “above” including many values. This does not mean that the siloxane claimed will degrade at 150°C, merely that one must heat it above this temperature for degradation to occur. Notice for instance in Example 9, the siloxane is heated to 250°C for the onset of weight loss, and the siloxane is heated to 400°C and 600°C to observe ceramic yields. Thus interpreting the phrase “thermally labile” in view of that taught by the specification still does not give a clear meaning of this phrase and certainly does not distinguish the claimed siloxane, which is defined by its structure, from the siloxane of Schank, having the same structure.

With regards to applicants’ comments that Schank does not teach that the substituent must contain an electronegative group in the beta position, applicants are reminded that Schank specifically prepare a siloxane having the required substituent and it is this that meets the structure required by the claims. Arguments regarding 2-chloromethyl substituted siloxanes are not pertinent to this anticipation/inherency rejection. Schank need not teach all of the properties of the siloxane claimed for anticipation.

5. Claims 1, 9, 11 to 13, 15 to 19 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alekna.

The rationale behind this rejection is consistent with that of record. Again, applicants’ remarks are insufficient to overcome this rejection.

Regarding the thermal lability of the claimed siloxane polymers, the Examiner relies on the rationale noted supra which indicates that a reflux temperature of between

190° and 230°C does not mean that the polymers of Schank cannot be considered thermally labile by applicants' standards.

With regards to claims 24 and 25, the phrase "consisting essentially of" does not distinguish the claimed siloxane from that in Alekna. Applicants use this language to distinguish the claimed siloxane from the siloxane resin system in Alekna, which contains a lead catalyst. However the siloxane resins are taught as an individual component that can be combined with other components to form the resin system. Thus Alekna suggest siloxanes such as claimed as an individual siloxane, which is subsequently combined with a lead catalyst. It is this siloxane that renders obvious that claimed and as such "consisting essentially of" fails to render the claimed siloxane unobvious.

6. Claims 3, 4, 6, 7, 10, 20 and 21 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret G. Moore whose telephone number is 703-

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308-4334. The examiner can normally be reached on Mon., Wed., Thurs. and Friday, 10am to 4pm..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Dawson can be reached on 703-308-2340. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9311 for regular communications and 703-872-9310 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.


Margaret G. Moore
Primary Examiner
Art Unit 1712

mgm
February 28, 2003